

REMARKS

Claims 1-39 are pending with claims 1, 17, 26 and 34 being independent. Claims 1, 17, 26-28 and 34 have been amended. No new matter has been added.

Applicant's specification provides support for amending claims 1 and 17 at least on page 9, ¶ [0032] and page 10, ¶ [0034]. The support for amending claim 26 is provided at least on page 17, ¶ [0058] – page 19, ¶ [0064]. The support for amending claim 34 is provided at least on page 5, ¶ [0023].

Rejections Under 35 U.S.C. § 103 Based on Sanctis and BT

Claims 1-7, 17, 21-24 and 34-36 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Publication No. 2005/0131837 to Sanctis et al. ("Sanctis") in view of European Patent Publication No. EP 1,309,153 A1 to British Telecommunications ("BT"). While Applicant disagrees with the Examiner's rejections, claims 1, 17 and 34 have been amended to expedite the prosecution of the present application.

Independent claim 1 and its dependent claims 2-7

Claim 1 has been amended as follows:

A method for advertising on a mobile device, the method comprising:
storing a plurality of advertisements on a mobile device;
initiating a wireless communication involving the mobile device;
determining a time required to complete the wireless
communication; and
selecting one of the stored advertisements to present on the mobile
device during at least a portion of the wireless communication if the determined
time is longer than a threshold time.

The proposed combination of Sanctis and BT fails to teach each and every feature of claim 1. In particular, the proposed combination of Sanctis and BT fails to teach the claimed ***selecting one of the stored advertisements to present on the mobile device***. In contrast, Sanctis is directed to sending to a mobile device a mobile alert message that the user must acknowledge and manually read in order to view a message related to the alert. (See Sanctis, ¶¶ [0042]-[0044].)

The mobile device 30 next determines at block 76 whether or not the user has entered a “Present Messages” input to invoke presentation of the mobile alert. If not, the process passes from block 76 to block 78....If, however, the mobile device 30 determines at block 76 that the user has entered a “Present Messages” input, the process passes to block 80.”

Id. at ¶ [0043].

“Block 80 illustrates the mobile device 30 presenting the mobile alert within the display 32 in accordance with the format of the mobile alert, and optionally, user preferences and/or the capabilities of the mobile device 30.”

Id. at ¶ [0044].

Thus, in Sanctis, even if an advertisement is sent to a mobile device attached to the mobile alert message, the trigger that presents the advertisement to the user on the mobile device display is an action by the user to “Present Messages.” *See* Sanctis at ¶ [0043]. The system in Sanctis does not *store a plurality of advertisements* and does not *select one of the stored advertisements to present to the mobile device*, as recited in claim 1.

The addition of BT fails to alleviate the deficiencies of Sanctis. The “additional data” presented to a mobile device in BT is not *selected from plurality of advertisements stored* in the mobile device, as recited in claim 1. (*See*, BT at ¶ [0004]-[0007].) In fact, BT suffers from the same deficiencies as Sanctis. For at least this reason, claim 1 is patentable over the proposed combination of Sanctis and BT.

Claims 2-7 depend from claim 1 and are patentable over the proposed combination of Sanctis and BT for at least the same reasons.

Independent claim 17 and its dependent claims 21-24

Claim 17 recites similar features as claim 1 and is patentable over the proposed combination of Sanctis and BT for at least reasons similar to claim 1. Claims 21-24 depend from claim 17 and are patentable over the proposed combination of Sanctis and BT for at least the same reasons.

Independent claim 34 and its dependent claims 35-36

Claim 34 recites similar features as claim 1 and is patentable over the proposed combination of Sanctis and BT for at least reasons similar to claim 1. In particular, the proposed combination of Sanctis and BT fails to teach or suggest the claimed *presenting a rotation of the*

stored advertisements on the mobile device during the period of delay in the wireless communication session if the determined time is longer than a threshold time, as recited in claim 34. Sanctis and BT are silent as to the claimed features.

For at least these reasons, claim 34 is patentable over the proposed combination of Sanctis and BT. Claims 35-36 depend from claim 34 and are patentable over the proposed combination of Sanctis and BT for at least the same reasons.

Rejections Under 35 U.S.C. § 103(a) Based on Sanctis, BT and Hamano

Claims 8-16, 18-20, 25 and 37-39 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sanctis in view of BT and further in view of U.S. Patent Application Publication No. 2002/0166127 to Hamano (“Hamano”).

Claims 8-16, 18-20, 25 and 37-39 depend from claims 1, 17 and 34 and are patentable over the proposed combination of Sanctis and BT for at least reasons similar to claims 1, 17 and 34 above. The addition of Hamano fails to alleviate the deficiencies of Sanctis and BT. Hamano discloses that “the remote display terminal start up screen can be used to display advertising during a period of time while the terminal is ‘booting up.’” (See, Hamano at ¶ [0023].) Thus, Hamano is restricted to displaying the advertisement during the “boot up” period only. Also, Hamano fails to disclose *storing a plurality of advertisements* and does not *select one of the stored advertisements to present to the mobile device*, as recited in claims 1 and 17. Further, Hamano fails to disclose *presenting a rotation of the stored advertisements on the mobile device during the period of delay in the wireless communication session if the determined time is longer than a threshold time*, as recited in claim 34.

For at least these reasons, claims 8-16, 18-20, 25 and 37-39 are patentable over the proposed combination of Sanctis, BT and Hamano.

Rejections Under 35 U.S.C. § 103(a) Based on Sanctis, Hamano and BT

Claims 26-28 and 30-33 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sanctis in view of Hamano and BT. While Applicant disagrees with the Examiner’s rejections, claims 26-28 have been amended to expedite the prosecution of the present application.

Independent claim 26 and dependent claims

The proposed combination of Sanctis, Hamano and BT fails to teach each and every feature of claim 26. In particular, the proposed combination of Sanctis and BT fails to teach the claimed *receive information related to one of the stored advertisements from the advertising*

application on the mobile device and update a database record associated with the one of the stored advertisements based on the received information. Sanctis, Hamano and BT are silent as to the claimed features.

For at least these reasons, claim 26 is patentable over the proposed combination of Sanctis, Hamano and BT. Claims 27-28 and 30-33 depend from claim 26 and are patentable over the proposed combination of Sanctis, Hamano and BT for at least the same reasons.

Rejections Under 35 U.S.C. § 103(a) Based on Sanctis, Hamano, BT and Donian

Claim 29 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sanctis in view of Hamano, BT and U.S. Patent Application Publication No. 2004/0003398 to Donian (“Donian”).

Claim 29 depends from claim 26 and is patentable over the proposed combination of Sanctis, Hamano and BT for at least reasons similar to claim 26. The addition of Donian fails to alleviate the deficiencies of Sanctis, Hamano and BT. In particular, Donian fails to disclose the claimed *receive information related to one of the stored advertisements from the advertising application on the mobile device and update a database record associated with the one of the stored advertisements based on the received information*, as recited in claim 26.

Donian is directed to providing to consumers “the free and unlimited use of secure media content, by offering, a free general license for use of content with paid commercial advertisements and other promotional material inserted into the content stream at certain intervals.” (See, Donian at ¶ [0115].) Thus, the advertisement in Donian is displayed to the user anytime the user request viewing of the secure media content, and Donian does not teach receiving the claimed *information related to one the stored advertisements and updating a database record associated with the one of the stored advertisements based on the received information*, as recited in claim 26.

In addition, claim 29 is patentable over the proposed combination of Sanctis, Hamano, BT and Donian for independent reasons. The Examiner concedes that the combination of Sanctis Hamano and BT fails to disclose the claimed *assigning a number of presentations for the selected new advertisement; and transmit the assigned number to the mobile device*, as required in claim 29. The addition of Donian fails to alleviate the deficiencies of Sanctis Hamano and BT.

While the Examiner alleges that Donian discloses the features at ¶ [0147], the cited portion of Donian fails to support the allegation. Donian discloses that “[w]ith segmented media, the player/viewer holds a sense of particular ad blocks retaining their own sense of place in the sequence, with the ads chosen to go along with a pre-determined portion of the content.” Donian, ¶ [0147]. However, claim 29 recites ***assigning a number of presentations for the selected new advertisement and transmit the assigned number to the mobile device.*** The claimed ***number of presentations assigned*** to the new advertisement relates to the number of times the new advertisement can be viewed on the mobile device. In contrast to this claimed feature, Donian does not teach or suggest assigning the number of times the new advertisement can be viewed on the mobile device. Thus, the segmented media with attached ads in Donian cannot reasonably be interpreted as ***assigning a number of presentations for the selected new advertisement and transmitting the assigned number to the mobile device,*** as recited in claim 29. Donian is silent as to the claimed features, and the Examiner fails to explain how the cited portions of Donian might reasonably be interpreted to disclose or suggest the claimed features.

For at least this additional reason, claim 29 is patentable over the proposed combination of Sanctis, Hamano, BT and Donian.

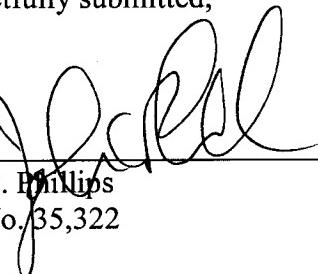
Conclusion

In view of the remarks and the claim amendments, all of the claims are in condition for allowance. A formal notice to that effect is respectfully requested.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Please apply \$225.00 for a two-month extension of time fee, \$395.00 for RCE fee and any additional charges or credits to deposit account 06-1050.

Respectfully submitted,


John C. Phillips
Reg. No. 35,322

Date: January 23, 2007

PTO Customer No. 20985
Fish & Richardson P.C.
12390 El Camino Real
San Diego, California 92130
Telephone: (858) 678-5070
Facsimile: (858) 678-5099

JCP/HCL/jhg
10679628.doc